REMARKS/ARGUMENTS

The Applicants respectfully request further examination and consideration in view of the claims above and arguments set forth fully below. Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 were previously pending in this application. Within the final Office Action mailed August 11, 2009, Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 stand rejected under 35 U.S.C. 103(a). By way of the above amendments, Claim 46 has been amended. Accordingly, Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are currently pending in this application.

Claim Rejections – 35 U.S.C. §103(a)

Within the Office Action, claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are rejected under § 103(a) as being unpatentable over the article titled "Argos Business Solutions: Customer Referral Scheme Encourages Sale of Mobile Phones" (hereinafter "Argos") in view of the article titled "recommend-it.com" (hereinafter "recommend-it"). The Applicants respectfully traverse these rejections.

Argos teaches a referral program that is designed to reward customers for referring family and friends to DX Communications to purchase a new mobile phone. According to Argos "the DX Collect scheme is a chequebook-based incentive programme. Customers refer colleagues, friends or family to DX by completing a DX Collect cheque with name and address details. Customers then collect points for purchases made by the referee. Discount on DX merchandise, up to GBP 300 worth or Argos vouchers and a GBP 1,000 holiday voucher are amongst the rewards available for between 1 to 40 successful referrals. Points are stored on a special database until customers are ready to select a reward." [Argos, page 1, paragraph 3] No other details are provided as to the implementation of this referral program. Argos provides no details as to the specific steps associated with the referral program. Argos simply teaches a first step where existing customers fill out a DX Collect cheque, and an end result where the referencing party (Customer) collects points for purchases made by the referee. We are left to guess at the intervening steps.

Recommend-it teaches a service whereby a first user can recommend a website to a second user. The recommendation comes in the form of an email sent by the recommend-it service to the second user. To initiate the recommendation, the first user completes a form provided by the recommend-it service. The recommendation form includes an option for the first user to receive a promotional newsletter. Although this option is presented on the same form that the first user fills out to recommend the website, the promotional newsletter is not an actual

reward for making the recommendation because the promotional newsletter can be received regardless of whether the first user makes the recommendation.

The Applicants maintain that the proposed combination of Argos in view of recommend-it cannot be made with a <u>reasonable expectation of success as required under MPEP 2143</u>. It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met:

1)   there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

2)   there must be a reasonable expectation of success; and

3)   the prior art reference, or references, must teach or suggest all the claim limitations. MPEP § 2143.

The burden of establishing a *prima facie* case of obviousness based on the teachings of Argos and recommend-it has not been met within the Office Action.

Within the Office Action, it is stated that "Argos Business Solutions doesn't specifically teach sending the recommendation via an e-mail message to the second party comprising a personalized referral for the marketable entity including a serial number and a URL link to the web site of the service provider and updating the database with the e-mail address of the second party." This is an oversimplification of the deficiencies of Argos, as Argos is nothing more than a marketing piece that announces the introduction of a new incentive scheme offered by DX Communications, as implemented by Argos Business Solutions. There are absolutely no details related to either the conceptual implementation details or a physical infrastructure used to implement this incentive scheme. The Examiner states that Argos "doesn't specifically teach sending the recommendation via an email message." In fact, Argos does not teach directly, or indirectly, any electronic means whatsoever for implementing the incentive scheme. There is no hint, teaching or suggestion within Argos that indicates the use of electronic means, such as an electronics communications network and infrastructure.

Within the Response to Arguments section, the Examiner asserts that using a communications network to perform the incentive scheme of Argos is taught in recommend-it, since recommend-it teaches using the internet for referring, rewarding and performing transactions in general. According to MPEP 2143 there must be a <u>reasonable expectation of success</u>. Recommend-it is cited as providing the network communication means. However, there is no indication within either Argos or recommend-it as to how the incentive scheme of Argos is to be implemented using a network communications means in general, or the internet of recommend-it. Even though recommend-it teaches network communication means, <u>there is no</u>

teaching as to an incentive scheme implemented by the recommend-it network communication means. The Examiner states that it is merely a manner of applying a network communications means, such as in the cited recommend-it, to the incentive scheme of Argos. However, the Examiner provides no means by which this can be accomplished. *The Applicants fail to see how the details of an incentive scheme can be implemented electronically, using a network communication means, when the details of the incentive scheme itself are not provided* (Argos provides insufficient implementation details to enable an electronics implementation). Not only would implementation details of the incentive scheme itself need to be guessed at (since Argos does not provide them in sufficient detail), but the means for implementing such guessed details would also have to be determined, especially in the added context of an electronics communication network. As neither Argos nor recommend-it provide such details, the burden would fall to experimentation on the part of the implementor. Such undue experimentation negates the obviousness of such a combination, and supports the position that the proposed combination of Argos in view of recommend-it does not have a reasonable expectation of success. Therefore, the proposed combination of Argos in view of recommend-it is not proper.

Even if the proposed combination of Argos in view of recommend-it is proper, neither Argos, recommend-it nor their combination teach at least the following limitations.

The Applicants respectfully submit that Argos, recommend-it and their combination do not teach the limitation, in one form or another, "**the first set of data comprising a first serial number and a first URL link to a first Web site of the Service Provider having an offer to transact an exchange for the marketable entity**" of Claims 1 and 50.

Within the Office Action, it is acknowledged that Argos fails to teach sending the recommendation via an e-mail message to the second party. It therefore follows that Argos does not teach that the first set of data of the e-mail includes a first URL link to a first Web site of the Service Provider. Therefore, Argos does not teach the claim limitation "**the first set of data comprising a first serial number and a first URL link to a first Web site of the Service Provider having an offer to transact an exchange for the marketable entity**."

Recommend-it teaches that the user can let his or her website visitors to quickly and easily tell their friends and colleagues about the website. For example, a sample email message is shown on page 4 of recommend-it. As shown, the Web Deck Software of recommend-it is offered by a third party, Web Deck, and *not by the Service Provider*. The service provided by the Recommend-it.com (tm) service merely provides a link to the Web Deck website. Once at the Web Deck website, any subsequent purchase made by a visitor is performed by Web Deck, *not by the Recommend-it (tm) service. Web Deck and recommend-it are two separate and distinct*

services/companies that function independently of each other. Therefore, recommend-it does not teach the claim limitation "**the first set of data comprising a first serial number and a first URL link to a first Web site of the Service Provider having an offer to transact an exchange for the marketable entity.**"

Accordingly, neither Argos, recommend-it nor their combination teach "**the first set of data comprising a first serial number and a first URL link to a first Web site of the Service Provider having an offer to transact an exchange for the marketable entity.**"

In addition, the Applicants respectfully submit that Argos, recommend-it and their combination do not teach the limitation, in one form or another, "**correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party**" of Claims 1 and 50.

Within the Office Action, the Examiner cites page 2, paragraph 1 and page 1, paragraph 3 of Argos and interprets these sections as teaching the claim limitation "**correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party.**" The Applicants respectfully disagree. Page 2, paragraph 1 of Argos states:

> "We felt that the Argos range of goods complemented our customer base very well. If the reward selected is Argos vouchers, customers can choose from a huge range of quality branded items such as sports goods, children's toys and garden equipment – catering for every age group, sex and status." [Argos, page 2, paragraph 1]

And, page 1, paragraph 3 of Argos states:

> Launched in May, the DX Collect scheme is a chequebook-based incentive programme. Customers refer colleagues, friends or family to DX by completing a DX Collect cheque with name and address details. Customers then collect points for purchases made by the referee. Discount on DX merchandise, up to GBP 300 worth of Argos vouchers and a GBP 1,000 holiday voucher are amongst the rewards available for between 1 and 40 successful referrals. Points are stored in a special database until customers are ready to select a reward. [Argos, page 1, paragraph 3]

The Applicants are unclear how these cited sections teach *correlating* the first set of data in the first e-mail message to any data, let alone to data within a database. The cited sections simply states the different of types of rewards a customer can choose from based on the collected points. These cited sections and other sections of Argos do not teach correlating the first set of data in the first e-mail message to any data. Further, the Applicants are unclear how these cited sections teach a database comprising data relating to the reward offered to the first party. Nowhere within

Argos does Argos mention any database. *To conclude that Argos teaches the different types of rewards are stored in a database is to read much more into Argos than its actual reading.* Therefore, Argos does not teach the claim limitation "**correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party**."

Within the Office Action, the Examiner cites page 2 of recommend-it and interprets this page as teaching the claim limitation "**correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party**." The Applicants respectfully disagree. Page 2 of the recommend-it does not show an e-mail message. Instead, page 2 of recommend-it simply shows a form that the user can fill out. The left frame teaches that the Recommend-it.com (tm) service will then send an email to up to three email addresses at the same time, detailing the site the user was just viewing. Recommend-it does not teach correlating the first set of data in the first e-mail message to any data. It therefore follows that recommend-it does not teach the claim limitation "**correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party**."

Accordingly, neither Argos, recommend-it nor their combination teach the limitation, in one form or another, "**correlating the first set of data in the first e-mail message to data within a database, the data within the database comprising data relating to the reward offered to the first party**."

In addition, the Applicants respectfully submit that Argos, recommend-it and their combination do not teach the limitation, in one form or another, "**updating the database with an e-mail address of the second party provided by the first party**" of Claims 1 and 50.

Within the Office Action, it is acknowledged that Argos does not teach the claim limitation "**updating the database with the e-mail address of the second party provided by the first party**." However, the Examiner cites pages 1-4 of recommend-it and interprets these pages as teaching this claim limitation. The Applicants respectfully disagree.

The cited four pages simply teach that the Recommend-it.com (tm) service that allows a user's website visitors know about the website. As illustrated on page 2 of recommend-it, the user is able to fill out a form, and the Recommend-it.com (tm) service constructs a personalized message regarding the website to those email addresses entered by the user. Although it is stated on page 2 that email addresses that travel through the Recommend-it.com (tm) service are never "sold, distributed, or published," nowhere within the four pages of recommend-it does recommend-it teach that the email addresses provided by the user are updated in the database. *To*

conclude that recommend-it teaches updating the database with the e-mail address of the second party is to read much more into recommend-it than its actual reading. Recommend-it does not teach the claim limitation "**updating the database with the e-mail address of the second party provided by the first party**."

Accordingly, neither Argos, recommend-it nor their combination teach the limitation, in one form or another, "**updating the database with the e-mail address of the second party provided by the first party**."

In addition, the Applicants respectfully submit that Argos, recommend-it and their combination do not teach the limitation "**a from field populated with an e-mail address of the first party**" of Claim 46.

As discussed above, Argos merely teaches a referral scheme that encourages sales of mobile phones. However, Argos does not teach any specific details of the referral scheme. Instead, Argos teaches a general functionality. Argos does not teach any e-mail messages. It therefore follows that Argos does not teach an e-mail comprising "**a from field populated with an e-mail address of the first party**."

Recommend-it teaches that the Recommend-it.com (tm) service will send an email to those email addresses listed by the user. A sample email message, as received, is illustrated on page 4. The email message comprises a header (lines 1-6), a message (lines 7-17) and, thereafter, an advertisement. In the header, the "to" field is populated based on the input in form line 4 of the form on page 2 by the user. The "from" field designates the recommend-it.com (tm) service. As such, recommend-it does not teach an e-mail comprising "**a from field populated with an e-mail address of the first party**."

Accordingly, the Applicants respectfully that neither Argos, recommend-it nor their combination teach the limitation "**a from field populated with an e-mail address of the first party**."

For at least these reasons, the combination of Argos and recommend-it fails to teach the claimed limitations as included in independent Claims 1, 46 and 50. Claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, and 43-45 depend from independent Claim 1. Claims 47-49 depend from the independent claim 46. Claim 51 depends from the independent claim 50. Because the dependent claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, 43-45, 47-49, and 51 are dependent on allowable base claims, they are also allowable.

Further, in regards to Claim 3, the Applicants respectfully submit that neither Argos, recommend-it nor their combination teach the limitation "**the step of updating the database with an e-mail address of the second party is performed through an e-mail field accessed by**

the first party through a Web browser" since Argos, recommend-it and their combination fails to teach updating any database, as discussed above.

Further, in regards to Claim 4, the Applicants respectfully submit that neither Argos, recommend-it nor their combination teach the limitation "**updating the database with an e-mail address of a third party provided by at least one of the first party and the second party**" since Argos, recommend-it and their combination fails to teach updating any database, as discussed above.

Further, in regards to Claim 8, the Applicants respectfully submit that Argos, recommend-it and their combination do not teach the limitation "**forwarding an authenticating e-mail message from the first party to a provider of the first Web site, the authenticating e-mail message comprising a first serial number and the e-mail address of the second party, the authenticating e-mail message thereby enabling the second party to access the first Web site and transact for the marketable entity.**" Argos merely teaches a referral scheme that encourages sales of mobile phones. However, Argos does not teach any specific details of the referral scheme. Instead, Argos teaches a general functionality. Argos does not teach any authenticating e-mail messages. It therefore follows that Argos does not teach this claim limitation. Recommend-it merely teaches that the Recommend-it.com (tm) service sends an email to the email addresses provided by the user. Recommend-it does not teach any authentication process. It therefore follows that recommend-it does not teach this claim limitation. Accordingly, neither Argos, recommend-it nor their combination teach the limitation "**forwarding an authenticating e-mail message from the first party to a provider of the first Web site, the authenticating e-mail message comprising a first serial number and the e-mail address of the second party, the authenticating e-mail message thereby enabling the second party to access the first Web site and transact for the marketable entity.**"

Further, in regards to Claim 9, the Applicants respectfully submit that neither Argos, recommend-it nor their combination teach the limitation "**the step of forwarding the first e-mail message to the second party and the step of forwarding the authenticating e-mail message to the provider are performed as the result of a single mail command initiated by the first party**" since Argos, recommend-it and their combination fails to teach forwarding an authenticating e-mail message from the first party to a provider of the first Web site.

Conclusion

      In view of the foregoing, the Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact the undersigned at (408) 530-9700.

                          Respectfully submitted,

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Dated: November 09, 2009   By: /Thomas B. Haverstock/

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